

REMARKS

Claims 1-20, 22, 24, 26-48, 50, 52, 54-76, 78, 80, and 82 were pending as of the action mailed on July 24, 2008. Reconsideration of the action is respectfully requested in light of the foregoing amendments and the following remarks.

The examiner rejected claims 1-15, 18-20, 22, 24, 26, 29-43, 46-48, 50, 52, 54, 57-71, 74-76, 78, and 80 under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 6,151,643 ("Cheng"). The examiner rejected claims 16-17, 28, 44-45, 56, 72-73, and 82 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cheng in view of U.S. Patent No. 6,904,592 ("Johnson"). The examiner rejected claims 27 and 55 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Applicant Admitted Prior Art ("AAPA").

Examiner's response to the applicants arguments

In responding to the applicant's arguments, the examiner describes his interpretation of the following feature of claim 1: "the update server does not receive or evaluate information about the client environment, does not make decisions regarding the update process on the client environment, and does not control or monitor the update process on the client environment."

In particular, the examiner states that:

This phrase must be read in view of Applicant's further disclosure of "the update client... sends one or more requests ... to the update server" (Specification: page 6, lines 13-14) and "the update server... can be implemented in a stateless server. A stateless server has no information about previous actions that involved the server. Upon request, the stateless server provides requested data without any further processing or consideration" (Specification: page 6, lines 23-26). Therefore, it is clear from Applicant's disclosure that the claims should be interpreted as: some information is sent from the client to the server so long as the server remains stateless and does not make decisions regarding "an update process". The fact that Cheng's service provider computer receives information from a client is entirely consistent with Applicant's definition, as both Applicant's server and Cheng's computer must receive information and, in order to function, must necessarily then make some "decisions" or "control" on that information. [Office action, pages 13-14]

The applicant respectfully disagrees. The examiner is impermissibly adding limitations to the claim from the specification. As set forth in MPEP § 2111.01 II, it is improper to import claim limitations from the specification. In particular, MPEP § 2111.01 II states that:

Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). See also *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment); *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims 'in view of the specification' without unnecessarily importing limitations from the specification into the claims."); *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) (Although the specification discussed only a single embodiment, the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). MPEP § 2111.01 pages 2100-38 to 2100-39 (Rev. 6, Sept. 2007) (*Emphasis added*).

The examiner has done exactly this in taking other implementations from the specification and importing them into the claim. The applicant respectfully submits that the claim feature should be read consistently with the actual language of the claim, namely that the update server does not receive or evaluate information about the client environment, does not make decisions regarding the update process on the client environment, and does not control or monitor the update process on the client environment, without importing other limitations from the specification.

The examiner further states that:

[T]he broadest reasonable interpretation of Applicant's claim language requires the "update server" to not receive or evaluate information about the client environment. There is no reason to believe the "update server" portion of Cheng's system (that is the portion that sends the database of updates) receives or evaluates such information. In fact, Cheng indicates the "update server" does not maintain any such information (column 13, lines 48-57). This is a disclosure of a stateless update server ("the potential unreliability of non-stateless remote

procedure call implementations by having the service provider computer... perform the analysis"). Applicant's analysis of figure 7 does not establish analysis (receiving, evaluation, control, decisions) on the "update server" as the database is sent to the client for analysis. Whether databases are intended for use in analysis is not the same as the server performing the analysis. [Office Action page 14]

The applicant respectfully submits that the examiner's interpretation is inconsistent with the requirements under 35 U.S.C. § 102. To establish anticipation, the examiner has to identify each and every element of the claim within a single reference. Instead, the examiner is interpreting silence with respect to one of the elements as a positive disclosure. Additionally, the examiner cited a portion referring to client actions which does not disclose actions taken or not taken by the server. The applicant respectfully submits that "there is no reason to believe" is not a proper ground of rejection. The rejection must be based on specific disclosures found in the reference. As MPEP § 2131 clearly states, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." MPEP § 2131 page 2100-67 (Rev. 6, Sept. 2007).

The examiner further states that:

Finally, that other portions of Cheng's service provider computer [which the examiner states corresponds to the claimed update server] may or may not receive and evaluate information (user profiles or advertisements) does not indicate that the "update server" portion performs these functions. The broadest reasonable interpretation of Applicant's claim language requires the update server does not make decisions regarding "an update process" (claim 1, lines 4 and 8-10). Clearly, with regard to Cheng, "an update process" reads upon the process whereby Cheng's stateless update server sends a database that is analyzed by the client computer. Any other processes of Cheng (whether characterized as update processes or otherwise) are irrelevant to the claim language as is. The claims are to "an update process" not all update processes or all processes in general. [Office Action pages 14-15]

The examiner's interpretation that the claimed update process refers to some update processes of Cheng but not others is improper. The applicant respectfully submits that the examiner can not pick and choose which update processes of Cheng to read on the claimed update process. Additionally, the examiner is attempting to partition Cheng's server such that only a portion corresponds to the claimed update server without providing support for such

action. The examiner can not ignore other update processes in Cheng that contradict the claim language just because the claim refers to “an update process” not “all update processes”. Claim 1 specifically states that the update server does not make decisions regarding the update process on the client environment, and does not control or monitor the update process on the client environment. The applicant respectfully submits that if any update process of Cheng fails to satisfy this requirement, the update server of Cheng does not disclose or suggest the update server of claim 1.

Section 102 Rejections

Claim 1

Claim 1 recites receiving update information from a stateless update server where the update server does not receive or evaluate information about the client environment, does not make decisions regarding the update process on the client environment, and does not control or monitor the update process on the client environment.

On page 4 of the Office Action mailed January 10, 2008, the examiner rejects this limitation citing Cheng, FIG. 1, element 102 and col. 13, lines 48-57. Element 102 of FIG. 1 shows a “service provider computer system” and the cited text reads as follows:

In the preferred embodiment, the analysis 204 is preferably performed by the client application 104 on the client computer 101. This reduces the network bandwidth required, and the potentially unreliability of non-stateless remote procedure call implementations by having the service provider 102 perform the analysis. It further increases the number of simultaneous users of the service provider computer 102. The analyze process is performed by the system analyzer 907 module of the client application 104.

The cited portion of Cheng teaches an analysis performed by the client application on the client computer. The analysis is of software products installed on the client computer (Cheng, col. 13, lines 46-47), and is used to “query the service provider computer to determine for which of these products there is an applicable update” (Cheng, col. 14, lines 41-44).

However, the cited portion of Cheng does not teach or suggest an update server that does not receive or evaluate information about the client environment, does not make decisions regarding the update process on the client environment, and does not control or monitor the update process on the client environment. While the cited portion of Cheng does identify an

action performed by the client, it is silent as to actions performed or not performed by a stateless server. The disclosure of an action performed by a client application does not disclose or suggest receiving updates from a stateless server as recited in claim 1. Moreover, the applicant respectfully submits that Cheng instead contradicts the limitations recited in claim 1.

For example, in the Abstract, Cheng discloses “the service provider computer system [which] stores in an update database...information for identifying in the client computers and the software products stored thereon, and information for determining for such products, which have software updates available” (emphasis added). Additionally, in col. 7, at line 54, Cheng further discloses “for each of the installed software products on the list, the client application 104 determines 205 if there is an applicable, or relevant update for the software product. This determination is made in consultation with the service provider computer 102, which maintains, as further described below, a database including a list of available software updates for numerous software products of diverse software vendors” (emphasis added).

Additionally, in describing FIG. 7, “the service provider computer”, Cheng describes an “update database 709 [which] maintains...information for identifying software products installed on a client computer 101, and for uniquely distinguishing the versions and names of installed software products” (Cheng, col. 10, lines 26-62). Moreover, in col. 19, at line 50, Cheng describes a “user profile database 711 [which] maintains a profile for each user containing information about which products the user has shown an interest...” (emphasis added). Finally, in col. 22, at line 28, Cheng describes an “advertising and information database”, where “the access that the service provider computer 102 has to the software profile of the client computers 101 lends itself to sending information, advertisements, and other promotional material that would be appropriate to each specific user, based on the software installed on the user's computer” (emphasis added).

Thus, the applicant respectfully submits that Cheng clearly requires the maintenance of an update database and a user profile database in the service provider computer. The update database maintains information for identifying software products installed on a client computer. The user profile database maintains a profile for each user containing information about which products the user has shown an interest. Additionally, the client application in Cheng consults with the service provider before determining if there is an applicable, or relevant update for the

software product. Thus, for example, by having the service provider aid in the determination of an applicable update, Cheng teaches a service provider that can make a decision regarding the update process on the client. Moreover, the service provider in Cheng sends information, advertisements, and other promotional material that would be appropriate to each specific user, based on the software installed on the user's computer.

Thus, Cheng discloses several operations associated with updating software that are performed on a server. To the extent that these operations are interpreted by the examiner as controlling, monitoring, and making decisions regarding the update process on the client, these server based operations are counter to the requirements of claim 1.

As set forth above, Cheng does not disclose or suggest an update server that does not receive or evaluate information about the client environment, does not make decisions regarding the update process on the client environment, and does not control or monitor the update process on the client environment, as recited in claim 1. Moreover, Cheng discloses a server that contradicts the features recited in claim 1. Therefore, the applicant respectfully submits that the examiner has not provided art rejecting each limitation recited in claim 1. Thus, the applicant submits that claim 1 is in condition for allowance.

Claims 29 and 57

Claims 29 and 57 include features corresponding to those of claim 1 and were rejected for the same reasons. Therefore, claims 29 and 57 are allowable for at least the reasons set forth above with respect to claim 1.

Remaining Claims

The remaining claims depend from independent claims 1, 29, and 57, and are allowable for at least the reasons that apply to those independent claims.

Withdrawal of the rejection under 35 U.S.C. § 102(b), is therefore respectfully requested.

Section 103 Rejections

Claims 28, 56, and 82

Claims 28, 56, and 82 recite a stateless server which does not receive or evaluate information about the client environment, does not make decisions regarding the update process

on the client environment, and does not control or monitor the update process on the client environment. The applicant respectfully submits that the combined teachings of Cheng and Johnson do not teach or describe this feature as noted above with respect to the rejection under 35 U.S.C. § 102(b). Additionally, the combined teachings of Cheng, Johnson, and AAPA do not teach or suggest this feature, and thus the applicant submits that claims 28, 56 and 82 are in condition for allowance.

Remaining Claims

Claims 16, 17, and 27 depend from independent claim 1, claims 44, 45, and 55 depend from independent claim 29, and claims 72 and 73 depend from independent claim 57. Claims 16, 17, 27, 44, 45, 55, 72, and 73 are allowable for at least the reasons that apply to the independent claims from which they depend.

Withdrawal of the rejection under 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

For the foregoing reasons, the applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the applicant's decision to amend or cancel any claim should not be understood as implying that the applicant agrees with any positions taken by the examiner with respect to that claim or other claims.

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